

REMARKS

This Amendment is submitted in connection with a Request for Continued Examination ("RCE") under § 37 C.F.R. 1.114. Effective upon acceptance of the RCE and this Amendment, applicant withdraws the pending appeal filed in response to the Final Office Action dated July 29, 2003.

In the Final Office Action all of the pending claims, namely claims 1 – 8, 10 – 17, 20 – 25, 28 – 62 and 65, were rejected as being unpatentable over various prior art references alone or in combination, as described in greater detail below. (It is noted that the Final Office Action also purports to reject claims 63 and 64, however these claims had previously been canceled in Amendment B.)

By this amendment, applicant has amended claims 1, 4, 5, 6, 7, 10, 11, 12, 13, 16, 24, 29, 30, 33, 34, 38, 39, 40, 41, 42, 43, 44, 47, 57, 60, 61 and 65. Claims 1 – 8, 10 – 17, 20 – 25, 28 – 62 and 65 remain pending.

Accompanying this Amendment is the "Declaration of Askok Vasuedo Under 37 C.F.R. § 1.131" showing that the present invention was reduced to practice prior to the publication date of the Japanese Yasuo patent publication ("Yasuo"). Yasuo was used by the examiner in the Final Office Action to reject claims 16, 17, 20 – 23, 47 – 52 and 61 – 65. (But, as noted above, claims 63 and 64 had previously been canceled.) With the removal of Yasuo as a reference, these claims should now be allowable.

*Admitted
Prior
Art
DA #2*

Continued prosecution and allowance of the pending claims in view of the foregoing amendments and following remarks are respectfully requested.

Claim Amendments

Several of the claims, identified in the above introductory remarks and in the listing of claims, have been amended to eliminate unnecessary or redundant verbiage, to improve readability and clarity, and to use consistent terminology. No new matter has been added. It is believed that the amendments are straightforward and do not require additional discussion.

Request for Clarification

In the first Office Action, all of the pending claims were rejected for obviousness-type double patenting over the parent application. In its responsive amendment, applicant offered to

file a "Terminal Disclaimer" upon receiving an indication of allowable subject matter. However, no Terminal Disclaimer has yet been submitted. No mention is made of the obviousness-type double patenting rejection in the subsequent Final Office Action, and so applicant is uncertain of the status of this rejection.

Traversal of Claim Rejections

Claims 1 – 8 and 34 – 41 – These claims were rejected as being obvious over Blankenship et al. (U.S. Pat. No. 5,726,684) in view of Kim et al. (U.S. Pat. No. 5,952,996). Applicant again submits that these references are directed to much different devices and there is no suggestion or motivation to combine their teachings. In particular, the device of Kim et al., is designed to determine the spot on a display screen at which an input device is *aimed*. The Kim et al. device is for narrow applications, such as video games, wherein it is desired to know where the output of a device is *aimed* so as to enable a user to point directly at screen objects without moving a cursor. In contrast, the mouse and trackball devices of Blankenship et al. do not rely on physically aiming the device output at a specific screen location. Rather such devices use the rotation of a ball to move a cursor or other pointer on a screen without regard to the aiming or specific orientation of the device. The Kim et al. device lacks a ball or other equivalent mechanism because it is superfluous to their device.

In order to operate effectively the Kim et al. device creates a relatively *narrow* beam because it relies on the small differences in beam intensity detected at the various receptors to calculate the position the beam is aimed at. A large number of receptors are used around the periphery of the screen for the sole purpose of enabling calculation of the aim of the device. In contrast the Blankenship et al. device uses a relatively broader beam so that the mouse/trackball signal can be detected without any need to specifically point the device at the screen. Since the aim of the mouse is superfluous to Blankenship et al., there would be no reason to employ the sensors used in Kim et al. Thus, there is no motivation to combine the aim sensing device of Kim et al. with the pointing device of Blankenship et al.

It is submitted that the examiner's "response" to the applicant's previous discussion of the inadequacy of this combination fails to demonstrate a reason *why* someone of ordinary skill in the art would have been motivated to combine the references. Specifically, the examiner

states: "Blankenship et al. teaches all the is required by the claims except for teaching the that the infrared sensor is disposed on the display frame so that wide angle infrared detection response is achieved, which is clearly disclosed by Kim et al. (see abstract)." (Final Office Action, page 17.) Applicant submits that this analysis is directly contrary to the law concerning the examiner's burden to show obviousness. Specifically, it is not enough for the examiner to say that most of what is claimed is contained in one reference, and that the missing piece is in a second reference. The examiner is required to do more, *i.e.*, to show that there is some suggestion or motivation for making the claimed combination. Thus, the examiner is required to show not just that the various elements of the claims exist in the prior art, the examiner must *also* show motivation for combining the aiming device of Kim, et al. with the mouse of Blankenship et al. Moreover, the examiner's statement that the abstract of Kim et al. relates to wide angle infrared reception lacks merit. There is no suggestion of wide angle reception in the Abstract.

Here it is plain that the examiner is picking and choosing features from much different prior art references, using the hindsight gained from the current application, in order to find a combination of references that contain all the of claimed elements. This is not a proper analysis.

change
Fujiooka
0,674,424

Claims 10 – 15 and 42 – 46 – These claims were rejected as being obvious over Junod et al. (U.S. Pat. No. 5,854,621) in view of Donovan (U.S. Pat. No. 5,252,968). Junod et al. shows a wireless mouse, having an on-board CPU, designed for reduced power consumption. The mouse has three operational states – normal, standby and sleep. The main difference in these states is the *rate* at which the photodetectors used to sense movement of the mouse ball are sampled (see, *e.g.*, Fig. 5 and related text). Donovan shows a mouse using pulsing of the optical signal to conserve power. Donovan synchronizes light pulses with the on/off state of his photoreceptors, such that whenever light is emitted from an LED, the corresponding photodetector is "on". The variable sampling rate device of Junod et al. and the pulsed device of Donovan are distinct techniques. It is submitted that the examiner has failed to show a proper rationale for combining these references. The references teach *alternative* ways of reducing power consumption, and there is no showing of motivation to combine.

*reason to
combine
see OA

Moreover, even if the teachings were combined, the combination does not show the claimed invention. Specifically, present invention uses both continuous sampling of the ball

position and pulsed sampling. There is nothing in either reference which suggest this combination. At most, the combination would lead one to design a multi-state device which uses pulsed light – not a device which sometimes uses pulsed light and other times does not.

With regard to claims 12 and 43, neither reference makes any suggestion of a power range switch. In rejecting these claims the examiner refers to a passage in Junod et al. which discloses a plurality of user selectable *transmission channels* for selecting the *frequency* of the mouse signal, so as to avoid interference if multiple devices are in operation in the same vicinity. There is nothing in Junod et al. which suggests that there is any difference in the power levels of the different transmission channels. Thus the availability of different transmission channels is entirely different than enabling the user to set the power output level of the device.

In the Final Office Action the examiner did not respond to applicant's arguments regarding the patentability of these claims in view of the prior art cited by the examiner.

Keep
rejection
Avalide RE150s
to combine &

Claims 16, 17 and 20 – 23, 47 – 52, 61, 62 and 65 – All of these claims were rejected as being obvious over combinations that include the Japanese Yasuo patent publication. Submitted herewith is the "Declaration of Askok Vasuedo Under 37 C.F.R. § 1.131" showing that the present invention was reduced to practice prior to the publication date of the Yasuo. In particular, the Vasuedo Declaration shows that all of the pertinent teachings of Yasuo had been reduced to practice by the applicant prior to the Yasuo publication date. Therefore, Yasuo cannot be used as a reference, and these rejections are now moot.

Admitted
Prior Art
Art 2

Claims 24, 25 and 28 – These claims were rejected as being obvious over Yeom et al. (U.S. Pat. No. 5,943,625) in view of Blankenship, et al. with Klein (U.S. Pat. No. 6,163,326) added as to claim 28. Yeom et al. teaches a combination of a mouse and cordless telephone which operates through a separate telephone transceiver located in a computer housing. The Examiner does not dispute that the telephone transceiver operates independently of the computer. The teachings of Yeom et al. are limited to a telephone which operates using a radio frequency transmitter, and the reference suggests that infrared would not be acceptable for telephone operation because it is limited to line of sight connection which is unacceptable for a cordless telephone. In one embodiment an rf transmitter is used for the telephone and an infrared transmitter is used for the mouse. It is submitted that it would not have been obvious to modify

the Yeom et al. reference such that both the mouse and telephone functionality would rely on infrared transmission as required by the claims. Further, there is nothing which suggests using a microphone as a data input device, as in claim 25. The telephone of Yeom et al. is not a data input device, as it appears to operate independently of the computer.

In response to applicant's prior comments showing that the combination of Yeom et al. and Blankenship, et al. does not make the present claims obvious, the examiner stated: "Yeom et al. teaches that it is possible to transmit and receive mouse control signals at a radio frequency (see column 5, lines 37 – 41). Therefore it makes it *possible* for the keypad information from the non-pointing device to transmit signals to the computer system (104)." (Final Office Action, page 17; emphasis added.) In order to show that claimed subject matter is obvious, the examiner is *required* to show more than the *possibility* that the prior art could be modified to achieve the claimed invention. The examiner is required to show some suggestion or other motivation for making the combination. Thus, it is insufficient to merely *assert* that keypad information *could possibly be* transmitted to the computer system. The examiner is required to show a prior art reference, or some other motivation suggesting why someone would do this. The examiner is resorting to mere speculation, using hindsight to reconstruct the claimed invention by stretching references beyond what they teach. *BLANKENSHIP, 1, 17-30*

NOT
THE
SAME
obvious
rejection

Claims 29 – 33 and 56 – 60 – These claims were rejected as being obvious over Oka in view of Long et al. Neither reference shows a computer with two pointing devices as is claimed. The examiner has ignored the requirement of these claims that there be a second "pointing device." Instead the examiner refers to a second "input" device – *i.e.*, a keyboard. Further, the arbitration circuit of Long et al. does not arbitrate signals from two pointing devices, it simply handles arbitration of signals from a variety of different I/O devices. *pointing device is 1 device* The defect in the examiner's rejection applies *a fortiori* to claim 30 – 32 and 57, which require that there be a port for a *third* pointing device. Thus, it is respectfully submitted that even if these references are combined they do not teach subject matter of the claims.

In response to applicant's prior comments, the examiner asserts that cursor keys and keyboard keys constitute "pointing devices" as used in the claims. The examiner is obliged to

construe claim terminology in accordance with its ordinary meaning, absent some special meaning assigned in the patent application.

A typical definition of "Pointing device" is as follows (from the internet site, Wikipedia):

"A pointing device is any hardware component that allows a user to input spatial data to a computer. CAD systems and Graphical User Interfaces (GUI) allow the user to control and provide data to the computer using physical 'gestures' - point, click, and drag - typically by moving a hand-held mouse across the surface of the physical desktop and activating switches on the mouse. Movements of the pointing device are echoed on the screen by movements of the mouse pointer and other visual changes.

"While the most common pointing device by far is the mouse, other kinds include trackball, touchpad, pointing stick, lightpen, various kinds of digitizing tablets which use a stylus, and even a special "data glove" that translates the user's movements to computer gestures.

Conspicuously absent from this definition is any reference to a keyboard. Simply put, those of ordinary skill in the art do not consider computer keyboards to be "pointing devices." Consistent with the above definition, and the common usage, the present application uses the term "pointing device" in a way which is exclusive of a computer keyboard.

WHA-EE
TAB, Function key
J, Y, H, B

The examiner's logic is further specious in that it divides a single keyboard into two different sections to find second and third "pointing" devices. The examiner suggests that keyboard "arrow" or cursor control keys are somehow different than the rest of the keyboard. By this logic every key on the keyboard is a separate pointing device.

In summary, the examiner is bound to use the accepted meaning of pointing device, and using that meaning, it is clear that Oka does not have multiple pointing devices as claimed.

Claims 53 and 54 – These claims were rejected under 35 U.S.C. § 102 as being anticipated by Yeom et al. Applicant submits that the rf transmission from the telephone of Yeom et al. is not computer data, but is merely audio information being sent to a separate "telephone transmit-receive apparatus" which happens to be installed in the computer housing. In the words of the patent the invention involves: "installing the base unit of a cordless telephone inside the chassis of either a laptop or a personal computer..." (Column 3, lines 22 – 24.)

Throughout the patent it is made clear that the telephone transmit-receive apparatus functions independently of the computer.

There is nothing in the reference which suggests audio information is processed by the computer. Thus, Yeom et al. does not meet the claim requirement that there be a "non-pointing device . . . for generating input information for the computer."

Similar to what was described above, the examiner's rejoinder to applicant's prior amendment was to assert that it could be *possible* to use the keypad of Yeom et al.'s phone to send data to the computer. This possibility is neither taught nor inherent in the reference and therefore there is no basis for the examiner to assert that the claim is anticipated.

Claim 55 – This claim, which is dependent on claim 53, was rejected as being obvious over Yeom et al. in view of Klein et al. Therefore, it is submitted that claim 55 is patentable for the same reasons discussed above in respect to claim 53. It is further noted that there is nothing in either reference which suggests the substitution of a joystick (as in Klein et al.) for the telephone of Yeom et al.


Conclusion

In view of the foregoing amendments and remarks, Applicants submit that the case is now in condition for allowance (subject to the possible filing of a terminal disclaimer) and such action is earnestly solicited. The examiner is invited to telephone the undersigned at the below listed number if doing so would advance the prosecution of the application.

April 6, 2004

Sheppard Mullin Richter & Hampton LLP
333 South Hope Street, Floor 48
Los Angeles, CA 90071-1406
Tel: (415) 774-3208
Fax: (415) 434-3947

Respectfully submitted,



David Schnapf
Registration No. 31,566